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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dayton, Ohio

Docket No. 8677.00

JAN 19 2006

Application of

Raymond L. Higgins et al.

Serial No. 09/930,907

Group Art Unit: 3624

Filed: August 16, 2001

Examiner: Alain L. Bashore

For: **ELECTRONIC CHECK PRESENTMENT WITH IMAGE INTERCHANGE
SYSTEM AND METHOD OF OPERATING AN ELECTRONIC CHECK
PRESENTMENT WITH IMAGE INTERCHANGE SYSTEM**

CERTIFICATE OF MAILING

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SECOND APPEAL BRIEF

Sir:

This second Appeal Brief is in furtherance of the second Notice of Appeal filed in this case on **November 22, 2005**. Three copies of the second Appeal Brief are filed herewith. There is no fee required to file this second Appeal Brief since a fee has already been paid when the first Appeal Brief was filed on May 10, 2005.

(1) REAL PARTY IN INTEREST

The present application is assigned to NCR Corporation of Maryland.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

The above-identified patent application was filed on August 16, 2001 with claims 1-16. In response to an Office Action mailed on July 7, 2004, claims 11-16 were canceled. In response to a final Office Action mailed on December 21, 2004, claims 2 and 7 were canceled. In response to an Advisory Action mailed on February 28, 2005, a Notice of Appeal was filed on March 17, 2005. A first Appeal Brief was filed on May 10, 2005. In response to an Office Action mailed on July 27, 2005, a second Notice of Appeal was filed on November 22, 2005. Thus, claims 2, 7, and 11-16 are canceled, and claims 1, 3-6, and 8-10 stand rejected.

Claims 1, 3-6, and 8-10 are being appealed and are attached as an appendix to this second Appeal Brief.

(4) STATUS OF AMENDMENTS

An Amendment of February 3, 2005 which canceled claims 2 and 7 and amended claims 1 and 6 was filed subsequent to the final rejection of December 21, 2004. The Amendment of February 3, 2005 was entered as per the Advisory Action of February 28, 2005.

(5) SUMMARY OF CLAIMED SUBJECT MATTER**Independent Claim 1**

A method is provided of operating an electronic check presentment with image interchange system 10 (see page 5, lines 21-22). The method comprises the steps of:

creating a number of electronic bundle files 20 based upon captured MICR data associated with items (see page 6, lines 8-11 and page 6, line 24 to page 7, line 5 of the specification);

processing cash letter files 30 (see Fig. 5) and captured image data associated with the items to create a first temporary list 40 (see Fig. 8) (see page 7, lines 11-26 and page 8, lines 6-19 of the specification);

processing the cash letter files and the electronic bundle files to create a second temporary list 50 (see Fig. 9) (see page 8, line 25 to page 9, line 3 of the specification);

merging the first and second temporary lists to create a merged list 60 (see Fig. 10) for creating an image presentment file (see page 9, lines 4-10 of the specification); and

creating an image presentment file 90 (see Fig. 15) in a predefined format structure suitable for sending from a sending bank to a receiving bank based upon the merged list (see page 10, lines 20-24 of the specification).

A number of advantages result by providing the merged list 60 of Fig. 10 during the process of creating the image presentment file 90 of Fig. 15. One advantage is that a validating process occurs when the merged list 60 of Fig. 10 is created. The validating process occurs when the merged list 60 is created because item data from two sources (i.e., the electronic bundle file 20 of Fig. 4 and the cash letter file 30 of Fig. 5) is compared to ensure that item data is correct and that all items are accounted for. Any discrepancy (e.g., extra or missing items, missing or invalid image pointers, data fields that do not match or have missing data, etc.) which is identified during item data comparison may be researched and resolved. Moreover, the merged list 60 may be used to ensure that image data exists and is available for each item in the merged list. Accordingly, the merged list 60 may be considered as a "validated" file for use in subsequent processing. (for this entire last paragraph, see page 11, line 20 to page 12, line 2 of the specification)

Independent Claim 6

An electronic check presentment with image interchange system 10 (see page 5, lines 21-22) comprises:

means 150 for creating a number of electronic bundle files 20 (see Fig. 4) based upon captured MICR data associated with items (see page 6, lines 8-11 and page 6, line 24 to page 7, line 5 of the specification);

means 200 for processing cash letter files 30 (see Fig. 5) and captured image data associated with the items to create a first temporary list 40 (see Fig. 8) (see page 7, lines 11-26 and page 8, lines 6-19 of the specification);

means 200 for processing the cash letter files and the electronic bundle files to create a second temporary list 50 (see Fig. 9) (see page 8, line 25 to page 9, line 3 of the specification);

means 200 for merging the first and second temporary lists to create a merged list 60 (see Fig. 10) for creating an image presentment file (see page 9, lines 4-10 of the specification); and

means 200 for creating an image presentment file 90 (see Fig. 15) in a predefined format structure suitable for sending from a sending bank to a receiving bank based upon the merged list (see page 10, lines 20-24 of the specification).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

An issue presented for review is whether each of claims 1, 3-6, and 8-10 is patentable over U.S. Patent No. 5,930,778 to Geer in view of (U.S. Patent No. 5,146,548 to Bijmagne and U.S. Patent No. 4,903,229 to Schmidt et al. (referred to herein as "Schmidt").

(7) ARGUMENT

Claims 1, 4, 5, 6, 9, and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Geer in view of (Bijnagte and Schmidt) and in further view of U.S. Patent No. 6,181,837 to Cahill et al. (referred to herein as “Cahill”).

Claims 3 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Geer in view of (Bijnagte and Schmidt) in further view of Cahill, and further in view of U.S. Patent No. 6,661,910 to Jones et al. (referred to herein as “Jones”).

Claims 1, 3-6, and 8-10

Applicant would like to respectfully point out that the rejection of each of claims 1, 3-6, and 8-10 of the present application is improper for at least the reasons explained hereinbelow.

First, Applicant would like to respectfully point out that Geer teaches that image data is added to other extracted check data for transmission to a bank (see column 9, lines 1-10 in the specification of Geer). In Geer, it appears that an “image presentment file” is created by simply adding image data to other extracted check data. However, nowhere does Geer disclose or even remotely suggest that an image presentment file is created from a merged list which has been created from a first temporary list and a second temporary list, wherein (i) the first temporary list is created based upon cash letter files and captured image data associated with items, and (ii) the second temporary list is created based upon cash letter files and electronic bundle files which, in turn, are based upon captured MICR data associated with the items.

Second, Applicant notes that the Examiner refers to column 17, lines 15-29 of Bijnagte to reject claims 1, 3-6, and 8-10 of the present application. In this regard, Applicant would like to respectfully point out that Bijnagte merely teaches that an image data file and a text data file are merged. It appears that the Examiner is interpreting “an image data file” in Bijnagte to be “one of two temporary lists” and “a text data file” in Bijnagte to be “the other one of the two temporary lists”.

However, Applicant would like to respectfully point out that each of claims 1, 3-6, and 8-10 of the present application recites (i) a first temporary list which is created based upon cash letter files and captured image data associated with items, and (ii) a second temporary list which is created based upon cash letter files and electronic bundle files which, in turn, are based upon captured MICR data associated with the items. It should be apparent that the first temporary list recited in each of claims 1, 3-6, and 8-10 of the present application is not just merely an image data file or a text data file as in Bij nagte. It should also be apparent that the second temporary list recited in each of claims 1, 3-6, and 8-10 of the present application is not just merely an image data file or a text data file as in Bij nagte.

Third, Applicant notes that the Examiner refers to column 1, lines 6-24 and lines 44-61 of Schmidt to reject claims 1, 3-6, and 8-10 of the present application. In this regard, Applicant would like to respectfully point out that Schmidt merely teaches that an information file and a form file are merged. Schmidt does not disclose or suggest (i) a first temporary list which is created based upon cash letter files and captured image data associated with items, and (ii) a second temporary list which is created based upon cash letter files and electronic bundle files which, in turn, are based upon captured MICR data associated with the items, as recited in each of claims 1, 3-6, and 8-10 of the present application.

Fourth, Applicant notes that the Examiner states “It would have been obvious to one with ordinary skill in the art to include creation of first and second temporary lists that are merged to create a merged list for creating an image presentment file because Bij nagte teaches the need of temporary list for merging purposes of data and image files (col 7, lines 17-36) and Schmidt et al teaches merging of data and images to make forms and that forms are common practice (col 1, lines 6-24 and lines 44-61).” In this regard, Applicant would like to respectfully point out that Geer discloses a complete and fully operational electronic check presentment with image interchange system in which an image presentment file is sent from a sending bank to a receiving bank (*emphasis of underlining added by Applicant*). Since Geer discloses a complete and fully operational electronic check presentment with

image interchange system in which an image presentment file is sent from a sending bank to a receiving bank, there would be no motivation at all for a person skilled in the art to look to teachings of another reference (i.e., Bijnagte and Schmidt in this case) to obtain a feature (i.e., the capability to send an image presentment file from the sending bank to the receiving bank) that Geer already discloses as having. In this regard, Applicant has respectfully requested that the Examiner explain why a person skilled in the art would be motivated to modify Geer to obtain a feature that it already discloses as having. However, the Examiner has provided no explanation.

Conclusion

In view of the forgoing reasons, it is clear that the rejection of claims 1, 3-6, and 8-10 under 35 U.S.C. Section 103(a) is improper and, therefore, should be withdrawn. It is respectfully requested that the Board reverse the rejection of claims 1, 3-6, and 8-10.

Respectfully submitted,



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(8) CLAIMS APPENDIX

1. (previously presented): A method of operating an electronic check presentment with image interchange system, the method comprising the steps of:
 - creating a number of electronic bundle files based upon captured MICR data associated with items;
 - processing cash letter files and captured image data associated with the items to create a first temporary list;
 - processing the cash letter files and the electronic bundle files to create a second temporary list;
 - merging the first and second temporary lists to create a merged list for creating an image presentment file; and
 - creating an image presentment file in a predefined format structure suitable for sending from a sending bank to a receiving bank based upon the merged list.
3. (original): A method according to claim 1, further comprising the steps of:
 - storing the captured image data in an image data repository; and
 - retrieving from the image repository any image data which is missing from the merged list.
4. (previously presented): A method according to claim 1, further comprising the steps of:
 - generating indexing data based upon the captured MICR data; and
 - storing the captured MICR data and the generated indexing data in a MICR data repository.

5. (previously presented): A method according to claim 4, further comprising the steps of:

retrieving from the MICR data repository the corresponding MICR data and the corresponding indexing data for each physical bundle of items; and

creating an electronic bundle file based upon the retrieved indexing data and the retrieved MICR data.

6. (previously presented): An electronic check presentment with image interchange system comprising:

means for creating a number of electronic bundle files based upon captured MICR data associated with items;

means for processing cash letter files and captured image data associated with the items to create a first temporary list;

means for processing the cash letter files and the electronic bundle files to create a second temporary list;

means for merging the first and second temporary lists to create a merged list for creating an image presentment file; and

means for creating an image presentment file in a predefined format structure suitable for sending from a sending bank to a receiving bank based upon the merged list.

8. (original): An electronic check presentment with image interchange system according to claim 6, further comprising means for storing the captured image data in an image data repository, and means for retrieving from the image repository any image data which is missing from the merged list.

9. (original): An electronic check presentment with image interchange system according to claim 6, further comprising means for generating indexing data based upon the captured MICR data, and means for storing the captured MICR data and the generated indexing data in a MICR data repository.

10. (original): An electronic check presentment with image interchange system according to claim 9, further comprising means for retrieving from the MICR data repository the corresponding MICR data and the corresponding indexing data for each physical bundle of items, and means for creating an electronic bundle file based upon the retrieved indexing data and the retrieved MICR data.

(9) EVIDENCE APPENDIX

None.

(10) RELATED PROCEEDINGS APPENDIX

None.